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In re the application of:

SAEKI et al.

Art Unit: 2838

Serial Number: 09/528,201

Examiner: P. Tibbits

Filed: March 17, 2000

Attorney Dkt. No.: 100353-09049

For: PROTECTION METHOD, CONTROL CIRCUIT, AND BATTERY UNIT

RESTRICTION RESPONSE UNDER 37 C.F.R. § 1.121

Commissioner for Patents
Washington, D.C. 20231

Date: August 21, 2001

Sir:

The Office Action dated July 27, 2001, has been received and noted. This paper and the following remarks are submitted as a full and complete response thereto.

This election is being made in response to the Office Action dated July 27, 2001, in which the Examiner identified four (4) independent and distinct inventions in the present application. The Examiner further required the Applicants, under 35 U.S.C. § 121, to elect a single invention for prosecution on the merits. The four (4) inventions identified by the Examiner are:

Group I. Claims 1-5, drawn to a method for protecting battery cells from over-discharging;

Group II. Claims 6-20, drawn to a control circuit which is controlled in accordance with the voltage of each of the battery cells;

Group III. Claims 21-35, drawn to a battery unit for supplying power to a load; and

Group IV. Claim 36, drawn to a control circuit in a protection circuit for a device having a discharge control switch.

Pursuant to the Examiner's requirement, the Applicants elect, with traverse, the subject matter of Group II, recited in claims 6-20, for prosecution on the merits.

Applicants respectfully disagree with the Examiner and respectfully traverse the restriction requirement for the following reasons.

According to MPEP § 803, two criteria must exist for a proper restriction requirement. First, the inventions must be independent or distinct as claimed. Second, there must be a serious burden on the examiner if a restriction is required. Applicants respectfully submit that the restriction requirement fails to satisfy at least the second criteria, and therefore the restriction requirement is improper.

Applicants respectfully submit that at least the second criteria has not been met because the Examiner has already made a search and examination of the entire application, and therefore another search and examination of the entire application can be made without serious burden on the Examiner. According to MPEP § 803, "[i]f a search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis Added by Applicants). The search and examination of the present application was sufficiently conducted in its entirety on claims 1-36 to result in a Notice of Allowance and Issue Fee Due dated March 13, 2001. As such, another search and examination of the present application can be made without creating a serious burden on the examiner. Therefore, even if the

present invention includes claims to independent or distinct inventions (not admitted), Applicants respectfully submit that the Examiner must, pursuant to MPEP § 803, examine claims 1-36 in its entirety on the merits without requiring a restriction.

Given the above election, Applicants respectfully submit that the application is in a condition for examination on the merits. Applicants also respectfully request that the Examiner reconsider the restriction requirement in view of the above remarks. Furthermore, Applicants respectfully request the Examiner to specifically provide reasons to support the conclusions in which the Examiner formulated her position with respect to the restriction requirement. Applicants respectfully request an early examination and favorable action on the merits.

In the event this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300.

Respectfully submitted,

AREN'T FOX KINTNER PLOTKIN & KAHN, PLLC



Sam Huang
Attorney for Applicants
Reg. No. P48,430

Customer No.: 004372
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810
SH:mvb
Enclosure: Associate Power of Attorney
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